

REMARKS

The Amendments

The independent claims are amended to incorporate the substance of claim 6 therein.

To the extent that the amendments avoid the prior art or for other reasons related to patentability, competitors are warned that the amendments are not intended to and do not limit the scope of equivalents which may be asserted on subject matter outside the literal scope of any patented claims but not anticipated or rendered obvious by the prior art or otherwise unpatentable to applicants. Applicants reserve the right to file one or more continuing and/or divisional applications directed to any subject matter disclosed in the application which has been canceled by any of the above amendments.

The Large/Small Entity Status

The application was recently subject to a license which takes it out of small entity status.

The Rejection under 35 U.S.C. § 103

The rejection of claims 1-5, 12-18 and 22-36 under 35 U.S.C. § 103, as being obvious over Shalaby (U.S. Patent No. 5,847,012) in view of Vonken (U.S. Patent No. 5,618,853) and Dorman (U.S. Patent No. 4,636,526) is respectfully traversed.

Initially, it is pointed out that the subject matter of claim 6 is now incorporated into each of the independent claims. The subject matter of claim 6, i.e., further reciting that the polymer used in the method and provided in the resulting product is "biocompatible," was not subject to this rejection and the Office Action indicated that claim 6 was allowable. Since all

of the claims now recite the feature of claim 6, the application should be in condition for allowance. But, for completeness, the following additional remarks are provided.

As was apparently recognized in the Office Action in view of the allowance of claim 6, the combined teachings of the prior art fail to teach or suggest method for preparing a porous biocompatible polymer material by both gas foaming and subsequent particulate leaching of a biocompatible polymer containing a leachable particulate. For example, the Vonken reference clearly does not contemplate use of a biocompatible material.

Applicants further submit that it would not have been obvious to one of ordinary skill in the art to combine the reference teachings in a manner which would suggest a method and resulting product combining porosity forming by gas foaming and particulate leaching. Essentially, applicants maintain their previous arguments that the references fail to provide any motivation for one of ordinary skill in the art to combine both gas foaming and particulate leaching to provide a porous a polymer material. The Shalaby and Dorman references disclose particulate leaching methods to form porous materials, Shalaby for medical applications and Dorman for hard tissue prosthetics. While the utilities for these two references are related, neither provides any suggestion to provide additional porosity in its material, by gas foaming or otherwise. Nor do these references provide any suggestion that additional porosity from gas foaming would be desired or useful for their objectives. Vonken discloses molded structures produced by extrusion which have porosity from gas foaming. The Vonken structures are taught to be useful as packaging, filter and insulating materials, not for any medical or biocompatible-related uses. Vonken provides no suggestion that additional porosity from particulate leaching would be desired or useful for their objectives. Although the raw material polymers used in the Vonken and Shalaby references have some overlap, this alone does not provide motivation for one of ordinary skill in the art to modify

Shalaby or Dorman by adding gas foaming or modify Vonken by adding particulate leaching. The art must suggest to one of ordinary skill in the art why it would be desirable to make a modification, not merely that a modification could theoretically be made. "The mere fact that the prior art may be modified in the manner suggested by the examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." In re Fritch, 23 USPQ 2d 1780 (Fed. Cir. 1992). The completely distinct utilities of the Vonken reference from Shalaby and Dorman directs away from the motivation of one of ordinary skill in the art to apply the teachings of one to the other. The only suggestion to combine the references comes from applicants' own teachings, which cannot support obviousness under 35 U.S.C. § 103.


For all of the above reasons, it is urged that the combined teachings of the references fails to render the claimed invention obvious to one of ordinary skill in the art. Thus, the rejection under 35 U.S.C. § 103 should be withdrawn.

It is submitted that the claims are in condition for allowance. However, the Examiner is kindly invited to contact the undersigned to discuss any unresolved matters.

The Commissioner is hereby authorized to charge any fees associated with this response or credit any overpayment to Deposit Account No. 13-3402.

Respectfully submitted,

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UMICH-4 C1